

DEC 18 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Alejandro Wiechers

Examiner: Te Y Chen

Serial No.: 09/747,219

Group Art Unit: 2161

Filed: December 18, 2000

Docket No.: 10001310-1

Title: NETWORK ASSEMBLY AND METHOD FOR INSERTING AN
IDENTIFICATION CODE**CERTIFICATE OF TRANSMISSION**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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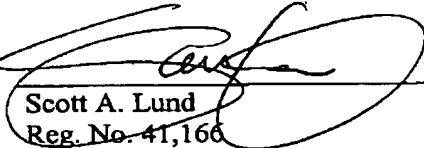
1. Transmittal Letter for Reply Brief (1 pg.); and
2. Reply Brief to Examiner's Answer (9 pgs.)

Respectfully submitted,

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11 PAGES – INCLUDING COVER PAGE

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PATENT APPLICATION

ATTORNEY DOCKET NO. 10001310-1IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Alejandro Wiechers

Confirmation No.: 3213

Application No.: 09/747,219

Examiner: Te Y Chen

Filing Date: December 18, 2000

Group Art Unit: 2161

Title: NETWORK ASSEMBLY AND METHOD FOR INSERTING AN IDENTIFICATION CODE

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEFTransmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on October 17, 2006.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

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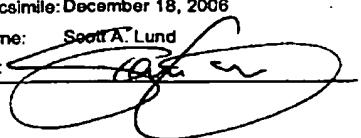
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Title: NETWORK ASSEMBLY AND METHOD FOR INSERTING AN
IDENTIFICATION CODE**REPLY BRIEF TO EXAMINER'S ANSWER****Mail Stop Appeal Brief – Patents**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir/Madam:

This Reply Brief is presented in response to the Examiner's Answer mailed October 17, 2006, and in support of the Notice of Appeal filed May 23, 2006 and the Appeal Brief filed July 20, 2006, appealing the rejection of claims 1, 3, 4, 7-9, 11, 12, 14 and 21-26 of the above-identified application as set forth in the Final Office Action mailed February 27, 2006.

At any time during the pendency of this application, please charge any fees required or credit any overpayment due to Deposit Account No. 08-2025 pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees required to Deposit Account No. 08-2025 under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Appellant respectfully requests reconsideration and reversal of the Examiner's rejection of pending claims 1, 3, 4, 7-9, 11, 12, 14 and 21-26.

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Reply Brief to Examiner's Answer
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 Filed: December 18, 2000
 Docket No.: 10001310-1
 Title: NETWORK ASSEMBLY AND METHOD FOR INSERTING AN IDENTIFICATION CODE

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ARGUMENT**Reply to Examiner's Response to Argument**

Regarding independent claims 1 and 21, as outlined in the Appeal Brief at pages 3, 4, and 6, independent claims 1 and 21 each receive an electronic file and characteristic information associated with the electronic file, assign a classification code to the electronic file based on the characteristic information, assign an inventory code to the electronic file based on whether the electronic file already exists in the system, compile an identification code for the electronic file from the classification code and the inventory code, and insert the identification code to the electronic file.

In the Examiner's Answer, the Examiner provides the following:

Moreover, the examiner respectfully points out that Seder et al. clearly discloses a document management system [e.g., Abstract, col. 1, lines 16-17] which includes software application to steganographic encoding of the document and update the database for a printable electronic document (or web page) [e.g., col. 1, lines 27-31]. Seder et al. further discloses "In accordance with one embodiment of the invention, a steganographic watermark is added to a document at the time of printing." [e.g., col. 2, lines 11-13], wherein, "the software application steganographic encoding of a page" reads on the claimed "coding an electronic file" and "the steganographic encode of a UID" or "the adding of a watermark" to a print page reads on the claimed "assigning a classification code to the claimed electronic file", because an "UID" and "a watermark" are deemed to represent a unique classification code for distinguishing one electronic file from others. (Examiner's Answer mailed October 17, 2006, sect. 10, pg. 11).

In the Examiner's Answer, the Examiner also provides the following:

In addition, Seder et al. clearly discloses assigning an inventory code to the electronic file based on whether the electronic file already exists in the system; for example, he discloses an electronic file marking technique can be implemented by steganographically assigning a Unique Identifier (UID at col. 1, lines 27-31) or bar code (at col. 7, lines 15-19), wherein, "the marking of a UID/bar code to an electronic file" reads on "assigning an inventory code to the electronic file" as claimed. (Examiner's Answer mailed October 17, 2006, sect. 10, pg. 11).

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At the onset, Appellant notes that several of the excerpts of the Seder et al. patent "quoted" by the Examiner in the Examiner's Answer are not actually present in the Seder et al. patent. For example, the excerpts of "the software application steganographic encoding of a page," "the steganographic encode of a UID," and "the adding of a watermark" are not present in the Seder et al. patent. In addition, the excerpt of "the marking of a UID/bar code to an electronic file" is not present in the Seder et al. patent. Furthermore, contrary to the contention of the Examiner, Appellant submits that the Seder et al. patent does not disclose steganographic encoding of and/or updating a database for a web page.

Nevertheless, as recognized by the Examiner in the Examiner's Answer, the Seder et al. patent does disclose a document management system wherein "a steganographic watermark is added to a document at the time of printing." (Seder, col. 2, lines 12-14). Appellant submits, however, that adding a steganographic watermark to a document at the time of printing is not the same as inserting an identification code to a received electronic file, as defined and recited in independent claims 1 and 21. More specifically, Applicant submits that neither adding a unique identifier to a printed page nor adding a barcode to a printed page represent inserting an identification code to a received electronic file, as claimed in independent claims 1 and 21.

For example, with the Seder et al. patent, the printed document is encoded such that by showing the printed document to a computer device with a suitable optical input device, an electronic version of the document can be recalled for editing (see, e.g., Seder, Abstract; col. 2, lines 12-19). Thus, the watermark (or other unique identifier) of the Seder et al. patent is used to encode the printed document whereby the electronic version of the document may be identified by the watermark (or other unique identifier). The electronic version of the document, however, is not encoded.

Thus, contrary to the contention of the Examiner, Appellant submits that the watermark (or other unique identifier) added to the document at the time of printing in the Seder et al. patent is not used for distinguishing an electronic file. Rather, the watermark (or other unique identifier) added to the document at the time of printing in the Seder et al. patent is used for distinguishing or identifying the printed document. Inserting an identification code to a received electronic file, as defined and recited in independent claims 1 and 21, however, may be used to identify or distinguish the electronic file.

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In addition, contrary to the contention of the Examiner, Appellant submits that assigning the unique identifier or bar code in the Seder et al. patent does not consider nor is it based on whether the document already exists in the system. Rather, the watermark (or other unique identifier) added to the document at the time of printing in the Seder et al. patent is based, for example, on a single item of status information about a document (such as confidential, do-not-copy, draft, etc.) or the date and time the document was printed (see, e.g., Seder, col. 2, lines 47-55). Thus, Appellant submits that neither adding a unique identifier to a printed page nor adding a barcode to printed page represent assigning an inventory code to an electronic file based on whether the electronic file already exists in the system, as claimed in independent claims 1 and 21.

Appellant also notes that independent claims 1 and 21 each assign a classification code to the electronic file based on the characteristic information, assign an inventory code to the electronic file based on whether the electronic file already exists in the system, compile an identification code for the electronic file from the classification code and the inventory code, and insert the identification code to the electronic file. Thus, independent claims 1 and 21 each assign two distinct codes (i.e., a classification code and an inventory code) to the electronic file, and compile a third code (i.e., an identification code) for the electronic file. As such, with independent claims 1 and 21, the compiled code (i.e., the identification code), as compiled from two distinct codes (i.e., the classification code and the inventory code), is inserted to the electronic file.

As outlined above, the watermark (or other unique identifier) added to the document at the time of printing in the Seder et al. patent is based, for example, on a single item of status information about a document (such as confidential, do-not-copy, draft, etc.) or the date and time the document was printed. The watermark (or other unique identifier) added to the document at the time of printing in the Seder et al. patent, however, is not compiled from two other distinct codes. Appellant, therefore, submits that adding the watermark (or other unique identifier) to the document at the time of printing in the Seder et al. patent does not represent inserting an identification code to a received electronic file, as claimed in independent claims 1 and 21.

Furthermore, contrary to the statement of the Examiner on page 12 of the Examiner's Answer, Appellant submits that the Seder et al. patent does not disclose indirect data

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encoding "which applies the application payload including classification code and the inventory code as an index into another data repository." Regarding the direct data encoding and the indirect data encoding referred to by the Examiner on page 12 of the Examiner's Answer, Appellant submits that the "direct data encoding" disclosed by the Seder et al. patent relies on textual or numerical information that is "literally" encoded by the watermark (or other unique identifier) such that with direct data encoding, the coded information (e.g., the data and time the document was printed) may be ascertained directly from the encoded coded data (see Seder, col. 2, lines 52-56).

The "indirect data encoding" disclosed by the Seder et al. patent, however, uses the encoded data as an "index" for another data repository such that with indirect data encoding coded information from the watermark (or other unique identifier) may only be ascertained by referencing an additional source (i.e., information is indirectly ascertained) (see Seder, col. 2, lines 56-65). Nevertheless, regardless of whether the encoding of the Seder et al. patent is "direct" or "indirect," Appellant submits that the Seder et al. patent is encoding the printed document. The Seder et al. patent, however, is not inserting an identification code to a received electronic file, as defined and recited in independent claims 1 and 21.

Once again, Appellant notes that to anticipate a claim under 35 U.S.C. 102, a reference must teach every element of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference").

Thus, for the reasons set forth above, as well as the reasons set forth in the Appeal Brief filed July 20, 2006, Appellant submits that the Seder et al. patent does not teach or suggest each and every element of independent claims 1 and 21. More specifically, Appellant submits that the Seder et al. patent does not teach or suggest receiving an electronic file and characteristic information associated with the electronic file, does not teach or suggest assigning a classification code to an electronic file based on characteristic information associated with the electronic file, does not teach or suggest assigning an inventory code to the electronic file based on whether the electronic file already exists in the system, does not teach or suggest compiling an identification code for the electronic file from

Reply Brief to Examiner's Answer**Appellant: Alejandro Wiechers****Serial No.: 09/747,219****Filed: December 18, 2000****Docket No.: 10001310-1****Title: NETWORK ASSEMBLY AND METHOD FOR INSERTING AN IDENTIFICATION CODE**

the classification code and the inventory code, and does not teach or suggest inserting the identification code to the electronic file.

Accordingly, Appellant submits that independent claims 1 and 21 are each patentably distinct from the Seder et al. patent. Furthermore, as dependent claims 3-4, 7-8, and 25 further define patentably distinct claim 1, and dependent claim 22 further defines patentably distinct claim 21, Appellant submits that these dependent claims are also patentably distinct from the Seder et al. patent. Appellant, therefore, respectfully submits that the rejection of claims 1, 3-4, 7-8, 21-22, and 25 under 35 U.S.C. 102(e) is not correct and should be withdrawn, and that claims 1, 3-4, 7-8, 21-22, and 25 should be allowed.

Regarding independent claims 9 and 23, as outlined in the Appeal Brief at pages 4, 5, and 8, independent claims 9 and 23 each receive an electronic file and characteristic information associated with the electronic file, assign a library-specific classification code to the electronic file based on the characteristic information and procedures of the library, assign a library-specific inventory code to the electronic file based on whether the electronic file already exists in the library, compile a library-specific identification code for the electronic file from the library-specific classification code and the library-specific inventory code, and insert the library-specific identification code to the electronic file.

As outlined above, contrary to the position of the Examiner, Appellant submits that the Seder et al. patent does not teach or suggest receiving an electronic file and characteristic information associated with the electronic file, does not teach or suggest assigning a classification code to an electronic file based on characteristic information associated with the electronic file, does not teach or suggest assigning an inventory code to the electronic file based on whether the electronic file already exists in the system, does not teach or suggest compiling an identification code for the electronic file from the classification code and the inventory code, and does not teach or suggest inserting the identification code to the electronic file.

Appellant, however, does agree with the Examiner that the Seder et al. patent does not disclose encoding procedures that are library-specific. As outlined in the Appeal Brief at page 9, Appellant, however, submits that the Van Huben et al. patent does not overcome the shortcomings of the Seder et al. patent.

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For example, the Van Huben et al. patent is related to the management of disparate forms of data generated, captured, transmitted, or otherwise manipulated by pervasive computing devices (see Abstract). The "library" references in the Van Huben et al. patent include, for example, reference to a "library organization" of a data management system and "library searching" of a data management system (see, e.g., Van Huben, col. 5, line 62 - col. 6, line 6; col. 6, lines 20-28). The Van Huben et al. patent, however, does not teach or suggest a library-specific classification code based on characteristic information of an electronic file and procedures of a library, does not teach or suggest a library-specific inventory code based on whether an electronic file already exists in a library, and does not teach or suggest a library-specific identification code compiled from a library-specific classification code and a library-specific inventory code, as defined and recited in independent claims 9 and 23.

Accordingly, Appellant submits that modifying the Seder et al. patent in view of the Van Huben et al. patent, in the manner suggested by the Examiner, does not overcome the shortcomings of the Seder et al. patent and, therefore, does not teach or suggest all of the limitations of independent claims 9 and 23. Once again, Appellant notes that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Thus, for the reasons set forth above, as well as the reasons set forth in the Appeal Brief filed July 20, 2006, Appellant submits that the Examiner has not established a *prima facie* case of obviousness of independent claims 9 and 23. More specifically, Appellant submits that the Seder et al. and Van Huben et al. patents do not teach or suggest receiving an electronic file and characteristic information associated with the electronic file, do not teach or suggest assigning a library-specific classification code to the electronic file based on the characteristic information and procedures of the library, do not teach or suggest assigning a library-specific inventory code to the electronic file based on whether the electronic file is already in the library, do not teach or suggest compiling a library-specific identification code for the electronic file from the library-specific classification code and the library-specific inventory code, and do not teach or suggest inserting the library-specific identification code to the electronic file.

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Accordingly, Appellant submits that independent claims 9 and 23 are each patentably distinct from the Seder et al. and Van Huben et al. patents. Furthermore, as dependent claims 11-12, 14, and 26 further define patentably distinct claim 9, and dependent claim 24 further defines patentably distinct claim 23, Appellant submits that these dependent claims are also patentably distinct from the Seder et al. and Van Huben et al. patents. Appellant, therefore, respectfully submits that the rejection of claims 9, 11-12, 14, 23-24, and 26 under 35 U.S.C. §103(a) is not correct and should be withdrawn, and that claims 9, 11-12, 14, 23-24, and 26 should be allowed.

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CONCLUSION

For the above reasons, Appellant respectfully submits that the art of record neither anticipates nor renders obvious the claimed invention. Thus, the claimed invention does patentably distinguish over the art of record. Appellant, therefore, respectfully submits that the above rejections are not correct and should be withdrawn, and respectfully requests that the Examiner be reversed and that all pending claims be allowed.

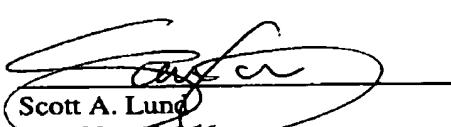
Any inquiry regarding this Reply Brief should be directed to either Nathan Rieth at Telephone No. (208) 396-5287, Facsimile No. (208) 396-3958 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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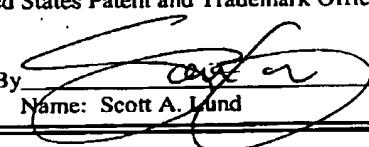
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By 
 Name: Scott A. Lund